

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SATISH KUMAR GAGGAR and FUH-SHENG CHEN

Appeal No. 1999-2488
Application No. 08/841,027

ON BRIEF

before HIMLIN, GARRIS, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claim 1 and from the refusal of the examiner to allow claims 2-4 and 5 as amended in response to the final rejection. There are all of the claims remaining in the application.

We believe that the phrase "said thing" is not limiting.

Appeal No. 1-89A-3484
Application No. 18-41,727

The subject matter on appeal relates to a method for improving heat/humidity aging resistance of a flame retardant thermoplastic composition. Further details of this appealed subject matter are set forth in representative independent claim 9 which reads as follows:

9. A method for improving heat/humidity aging resistance of a flame retardant thermoplastic composition, comprising the steps of:

- (a) providing an aromatic polycarbonate resin present at a level of from 60 to 90 percent by weight based on the total weight of the composition,
- (b) providing a vinyl aromatic-unsaturated nitrile-diene rubber graft copolymer present at a level of from 3 to 15 percent by weight based on the total weight of the composition,
- (c) providing a vinyl aromatic-unsaturated nitrile rigid resin present at a level of from 1 to 10 percent by weight based on the total weight of the composition,
- (d) providing a phosphate present at a level of from 3 to 15 percent by weight based on the total weight of the composition; and
- (e) providing a tetrafluoroethylene polymer present at a level of from 1 to 10 percent by weight based on the total weight of the composition, wherein said diene rubber or said graft copolymer is present at a level of from 1 to 10 percent by weight based on the total weight of the composition whereby said composition remains stable in the solid state and in the molten state.

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The references set forth below are relied upon by the examiner as evidence of obviousness:

Buyisch et al. - Buyisch	4,883,835	Nov. 28, 1984
Gosens et al. - Gosens	5,204,394	Apr. 20, 1993
Yang et al. - Yang	5,643,931	Jul. 1, 1997

(filed Nov. 1, 1994)

All of the claims on appeal are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang, Gosens and Buyisch.

We refer to the brief and to the answer (as well as to the first office action mailed August 11, 1997 as paper no. 11 to which the answer refers) for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

OPINION

For the reasons which follow, we will sustain this rejection.

On page 6 of the brief, the appellants state that "[t]he following table illustrates the compositions disclosed by the prior art references cited against the instant invention, comparing the prior art compositions to the invention."

As indicated by the appellants on page 7 of the brief, "the claims of the appeal all stand or fall together." Accordingly in assessing the merits of the above noted rejection, we will consider

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Application No. 08/841,027

composition." Consistent with the representations made in this table, the appellants then go on to argue that the applied references contain no teaching or suggestion to remove the diphosphate fire retardant or the low molecular weight halogen containing fire retardant of the Yang and Buysch compositions respectively in order to thereby obtain their inventive composition wherein only one fire retardant component, namely, a monophosphate fire retardant, is used. These arguments are unpersuasive.

This is because, contrary to the appellants' apparent belief, the subject matter on appeal simply is not limited in the manner argued in the brief. Specifically, neither of the appealed independent claims excludes diphosphate fire retardant or low molecular weight halogen containing fire retardant or limits the recited composition to only one fire retardant component as implicitly presupposed by the appellants' arguments. In this regard, we emphasize that the appealed independent claims should employ the term "comprising" which permits the inclusion of other steps, elements or materials such as the aforementioned diphosphate fire retardant and low molecular weight halogen containing fire retardant. In re Baxter, 40 F.3d 873, 880,

Appeal No. 1988-1448
Application No. 7-41,177

Moreover, it is appropriate to clarify certain incorrect findings of fact made by the appellants in presenting their argued arguments. First, neither of the independent claims on appeal nor in that matter any of the dependent claims on appeal requires that the phosphate component of the composition recited in the here claimed method constitute a monophosphate fire retardant as the appellants seem to believe. Additionally, the appellants are clearly incorrect in stating that Gosens' composition does not include a copolymeric resin of the type here claimed (i.e., the resin recited in step (c) of the independent claims). This resin is unambiguously disclosed as a component of Gosens' composition in lines 1-29 of column 4.

Finally, the appellants present the following argument on page 11 of the brief:

The Examiner's statement that "[a]ll of applicants claim limitations are met" is erroneous because of Appellants' clause reciting "whereby said composition retains about 50% of its original ball impact strength after one week aging at 100°C." (emphasis supplied) Appendix, Claim 1. This is the only place in the brief that suggests or recites this condition.

Initially, it is appropriate to point out that Appellant independent claim 10 contains no recitation concerning such a "condition." In any event, as correctly indicated by the

Examiner, the condition is not a limitation of the claim.

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Application No. 08,641,037

contain some of the ingredients defined by independent claim 1 in concentrations which encompass or overlap the claim concentrations. Therefore, the composition products defined by appealed claim 1 and disclosed by Yang or Buysch appear to be identical or substantially identical.

Where, as here, the claimed and prior art products are identical or substantially identical, the Patent and Trademark Office can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

The rejection is sustained in part because the prior art products do not necessarily or inherently possess the characteristics of the claimed product under consideration. On the other hand, it is reasonable to believe that the prior art

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Application No. 08/541,027

characteristics as the here claimed compositions in light of the aforementioned ingredient/concentration commonalities. Under these circumstances, the appellants' mere argument to the contrary must be considered unpersuasive. Id.

For the above stated reasons, we hereby sustain the examiner's Section 103 rejection of all appealed claims as being unpatentable over Yang, Gosens and Buysch.

1. *Chlorophyll a* and *Chlorophyll b* were determined by the method of Lichtenthal and Whistler (1973).

Figure 1. The effect of the concentration of the *Agrobacterium* suspension on the transformation efficiency of *Agrobacterium* strains. The concentration of the *Agrobacterium* suspension was 10⁶ cells/ml (A), 10⁷ cells/ml (B), 10⁸ cells/ml (C), and 10⁹ cells/ml (D). The concentration of the *Agrobacterium* suspension was 10⁶ cells/ml (A), 10⁷ cells/ml (B), 10⁸ cells/ml (C), and 10⁹ cells/ml (D). The concentration of the *Agrobacterium* suspension was 10⁶ cells/ml (A), 10⁷ cells/ml (B), 10⁸ cells/ml (C), and 10⁹ cells/ml (D). The concentration of the *Agrobacterium* suspension was 10⁶ cells/ml (A), 10⁷ cells/ml (B), 10⁸ cells/ml (C), and 10⁹ cells/ml (D).

The answer : the examiner is affirmed.

No time period for taking any subsequent action in:


A motion with this appeal may be extended under 37 CFR

AFFIRMED

Edward C. Kimlin
EDWARD C. KIMLIN
Administrative Patent Judge

BRADLEY R. GARRIS
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES


BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

Appeal No. 1288-2485
Application No. 35/541,027

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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

NOTICE OF ABANDONMENT

This application is abandoned in view of:

- ☐ Applicant's failure to timely file a proper response to the Office letter mailed on _____.
- ☐ A response (with a Certificate of Mailing or Transmission of _____) was received on _____, which is after the expiration of the period for response (including a total extension of time of _____ month(s)) which expired on _____.
- ☐ A proposed response was received on _____, but it does not constitute a proper response to the final rejection.

(A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC).)

- ☐ No response has been received.
- ☐ Applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.
- ☐ The issue fee (with a Certificate of Mailing or Transmission of _____) was received on _____.
- ☐ The submitted issue fee of \$ _____ is insufficient. The issue fee required by 37 CFR 1.18 is \$ _____.
- ☐ The issue fee has not been received.

Applicant's failure to timely file new formal drawings as required in the Notice of Allowability.

Proposed new formal drawings (with a Certificate of Mailing or Transmission of _____) were received on _____.

- ☐ The proposed new formal drawings filed _____ are not acceptable.
- ☐ No proposed new formal drawings have been received.

The express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on _____.

The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest or all of the applicants.

The decision by the Board of Patent Appeals and Interferences (BPAI) for seeking court review of the decision has expired and there are no allowed claims.

The reason(s) below:

PETER SZEKELY
PRIMARY EXAMINER